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Varsity Brands, Inc. v. Star Athletica, LLC

61 N.Y.L. SCH. L. REV. 239 (2016–2017)

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“[C]opyright law reform is slow, broad-based, and premised on a one-size-fits-all approach”¹ Such an approach is problematic to copyright law because it disrupts a court’s ability to focus on specific characteristics of individual works. It fails to consider the presence or absence of the particular traits that ultimately determine a work’s copyrightability.²

Broad, court-created tests used to determine the copyrightability of two-dimensional pictorial, graphic, or sculptural (PGS) works do not apply equally to all works found within an artistic category. Creating tests of this nature³ can lead to inconsistent copyright protection for two-dimensional PGS works,⁴ and functionally limit the scope of protection because categorizing original works into generic groups overlooks the very traits that may render a work copyrightable. This approach to copyrightability contradicts the purpose of the Copyright Act of 1976 (the “Act”), which is to afford consistent protection to “original works of authorship fixed in any tangible medium of expression.”⁵ While it is easier to create broad, vague tests than narrowly tailored ones,⁶ the detriment of broadness and vagueness to furthering the Act’s purpose should impel more individualized inquiries.

In *Varsity Brands, Inc. v. Star Athletica, LLC*, a case involving PGS works, the plaintiff sued the defendant for copyright infringement when the defendant sold merchandise incorporating designs that were substantially similar to those found on the plaintiff’s products.⁷ The Sixth Circuit held that the fabric designs on the plaintiff’s cheerleading uniforms were copyrightable because they were conceptually

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1. Shyamkrishna Balganesh, *Stewarding the Common Law of Copyright*, 60 J. COPYRIGHT Soc’y U.S.A. 103, 104 (2013).
 2. “Copyrightability” is a term of art that is derived from the Copyright Act. *See* 17 U.S.C. § 102 (2012). A work is copyrightable, and is thus protected under the Act, when it is both original and fixed in a tangible medium of expression. *Id.*
 3. *Infra* pp. 244–46.
 4. *Compare* *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488 (4th Cir. 1996) (holding that the plaintiff’s animal mannequins were copyrightable because their utilitarian purpose was conceptually separable from the sculptural features, which reflected the plaintiff’s artistic judgment), *and* *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980) (holding that the appellant’s belt buckles were conceptually separable from their utilitarian function and therefore copyrightable), *with* *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987) (determining that a bicycle rack was not copyrightable because the aesthetic elements were not conceptually separable from the utilitarian elements), *and* *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411 (2d Cir. 1985) (holding that mannequins of partial human torsos were not conceptually separable from their utilitarian function, and therefore not copyrightable).
 5. 17 U.S.C. § 102(a).
 6. *See* *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 487 (6th Cir. 2015) (“These cases . . . illustrate that it is difficult to select one approach to the question whether an artistic design is conceptually separable from the utilitarian aspects of the article. We adopt a similar hybrid approach now.”).
 7. *Id.* at 470–75.

separable⁸ from the intrinsic utilitarian function⁹ of the uniforms.¹⁰ The court created and applied a hybrid approach that combined various conceptual separability tests utilized by other circuits and scholars.¹¹

This case comment contends that although the Sixth Circuit reached the proper conclusion, it erred when it created and applied a hybrid conceptual separability test. The subjective nature¹² of the hybrid test¹³ makes it an inferior approach to determine conceptual separability; several other straightforward, objective tests were already in use in the courts.¹⁴ The court should have adopted the primary-subsidary test set

8. “Conceptual separability” is a term of art derived from the definition of PGS works in the Act that refers to a PGS work’s separate and distinct identity. *See* 17 U.S.C. § 101. “Conceptual separability means that a feature of the useful article is clearly recognizable as a pictorial, graphic, or sculptural work, notwithstanding the fact that it cannot be physically separated from the article by ordinary means.” *Varsity*, 799 F.3d at 483 (quoting U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924.2(B) (3d ed. 2014)). Courts focus extensively on this analysis because if the design of an article is not separable from its utilitarian function, the design is not copyrightable under the Act. *See* *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411 (5th Cir. 2005); *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913 (7th Cir. 2004); *Carol Barnhart*, 773 F.2d 411; *Jovani Fashion, Ltd. v. Cinderella Divine, Inc.*, 808 F. Supp. 2d 542 (S.D.N.Y. 2011).

9. The Act does not define the term “utilitarian function.” *See* 17 U.S.C. § 101. However, it defines “useful article” as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.” *Id.* According to the Merriam-Webster dictionary, the term “utilitarian” means “made to be useful rather than to be decorative or comfortable.” *Utilitarian*, MERRIAM-WEBSTER, <http://www.merriam-webster.com/dictionary/utilitarian> (last visited Feb. 6, 2017). What constitutes an object’s “utilitarian function” is fact specific and depends on the object’s basic function. For example, the Fourth Circuit stated in *Superior Form Builders*:

The objective in designing a chair is to create a utilitarian object, albeit an aesthetically pleasing one; the objective in creating a statue of a dancer is to express the idea of a dancer. As the Act makes the distinction, a useful article has as its function something more than portraying its own appearance.

74 F.3d at 493.

10. *Varsity*, 799 F.3d at 492.

11. *Id.* at 487–89; *see infra* note 41 and text accompanying notes 41–47.

12. Hybrid tests are subjective in nature because they comprise multiple tests. *See infra* note 13; *see also* James G. Wilson, *Surveying the Forms of Doctrine on the Bright Line-Balancing Test Continuum*, 27 ARIZ. ST. L.J. 773, 801 n.128 (1995) (“The Court must engage in a meta-subjective balancing test to determine which factors, objective and subjective, to include in its final formulation of doctrine.”). Courts are left to determine which individual tests within a hybrid bear more weight in any individual case; this requires a degree of subjective judgment. *See infra* pp. 252–53, for a discussion about the policy implications of the *Varsity* court’s decision to utilize a hybrid approach to conceptual separability.

13. Hybrid tests are different from balancing tests. *Black’s Law Dictionary* defines “balancing test” as “[a] doctrine whereby an adjudicator measures competing interests and decides which interest should prevail.” *Balancing Test*, BLACK’S LAW DICTIONARY (10th ed. 2014). Hybrid tests are a combination of multiple theories or preexisting tests. Wilson, *supra* note 12, at 773. Each preexisting test has different factors that contribute to the legal analysis. Balancing tests are individual tests with different components that factor into a legal analysis. *See generally id.* (discussing different tests utilized by courts). Any factor may be given more weight in a given case but all factors are part of the same test. *Id.* at 805 & n.148.

14. For a list and explanation of the nine objective tests that existed at the time of the Sixth Circuit’s decision, *see infra* note 41.

forth by the Second Circuit in *Kieselstein-Cord v. Accessories by Pearl, Inc.*,¹⁵ limiting the test's application to garment designs. Had the court done so, it also would have avoided issues pertaining to the aesthetic nondiscrimination principle¹⁶ because the primary-subsidary test focuses on the relationship between a work's artistic features and its utilitarian function.¹⁷ The Sixth Circuit's new hybrid test establishes confusing precedent that will yield inconsistent results and create unnecessary complexity in the conceptual separability arena.¹⁸

Varsity Brands, Inc. ("Varsity") is a Tennessee-based company that designs and manufactures cheerleading uniforms.¹⁹ Varsity's designers sketch "original combinations, positionings, and arrangements of elements which include V's (chevrons), lines, curves, stripes, angles, diagonals, inverted V's, coloring, and shapes."²⁰ Varsity uses one of four methods to transfer the designs onto the fabric: "cutting and sewing panels of fabric and braid together; sublimation; embroidery; or screen printing."²¹ After manufacturing is complete, Varsity sells its merchandise online and in catalogs.²² Varsity holds copyrights for many of its two-dimensional designs, including those at issue in the instant case.²³

Star Athletica, LLC ("Star") also markets and sells sports uniforms and athletic apparel for cheerleading, basketball, football, lacrosse, and baseball,²⁴ and utilizes similar marketing techniques.²⁵ After seeing the advertisements of Star's 2010 designs, Varsity sued in the Western District of Tennessee alleging copyright infringement against Star under the Act.²⁶ Varsity claimed that Star sold, distributed,

15. 632 F.2d 989 (2d Cir. 1980).

16. For an explanation of this principle, see *infra* note 92. See also DONALD S. CHISUM ET AL., UNDERSTANDING INTELLECTUAL PROPERTY LAW § 4C[1][d] (2d ed. 2011) (discussing the aesthetic nondiscrimination principle).

17. *Kieselstein-Cord*, 632 F.2d at 993–94.

18. Robert Kirk Walker & Ben Depoorter, *Unavoidable Aesthetic Judgments in Copyright Law: A Community of Practice Standard*, 109 NW. U. L. REV. 343, 367 (2015) ("[C]ourts face a difficult challenge determining conceptual separability. But by randomly switching between major aesthetic theories that are theoretically incompatible, courts make this challenge even more difficult for themselves, and as a consequence, the case law fails to provide artists with guidance as to the scope of protection available to such works.").

19. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 471, 494 (6th Cir. 2015).

20. *Id.* at 471 (citation omitted).

21. *Id.* (footnote omitted) (citation omitted). "Sublimation involves printing the design on a piece of paper. The paper is then fed through a machine that heats the ink on the paper into a gas which is infused into the fabric by pressing the paper and fabric together." *Varsity Brands, Inc. v. Star Athletica, LLC*, No. 10-2508, 2014 WL 819422, at *4 (W.D. Tenn. Mar. 1, 2014), *vacated*, 799 F.3d 468.

22. *Varsity*, 799 F.3d at 471.

23. *Id.*

24. *Id.* at 474.

25. *Varsity*, 2014 WL 819422, at *2.

26. *Varsity*, 799 F.3d at 474–75.

and advertised cheerleading uniforms that copied and were substantially similar to five of its copyrighted designs.²⁷

In the district court, Star argued that it was entitled to summary judgment on all of Varsity's claims, arguing that Varsity's copyrights were invalid because "(1) Varsity's designs are for useful articles, which are not copyrightable; and (2) the pictorial, graphic, and sculptural elements of Varsity's designs were not physically or conceptually separable from the uniforms, making [them] ineligible for copyright protection."²⁸ Varsity argued that it was entitled to summary judgment because its designs were nonfunctional and conceptually separable from the uniforms and therefore Star's conduct constituted copyright infringement.²⁹

Relying on the language of the Act, the district court granted Star's motion for summary judgment.³⁰ The Act provides:

[Pictorial, graphic, and sculptural works] include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article . . . shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.³¹

The Act further defines a "useful article" as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information."³² The district court determined that the utilitarian function of a cheerleading uniform is to identify oneself as a cheerleader, and the colors, shapes, stripes, and similar designs make the apparel recognizable as a cheerleading uniform.³³ Therefore, the designs were fundamental to the clothing as a cheerleading uniform.³⁴ The district court found that Varsity's designs were not physically or conceptually separable from the uniform because they merged with the functional aspects of the uniform and evoked the concept of cheerleading in the viewer's mind.³⁵ Thus, the court found that the designs were not copyrightable.³⁶ Varsity appealed.³⁷

27. *Id.*

28. *Id.* at 475.

29. *Id.*

30. *Id.*

31. 17 U.S.C. § 101 (2012).

32. *Id.*

33. *Varsity*, 799 F.3d at 475.

34. *See id.*

35. *Varsity Brands, Inc. v. Star Athletica, LLC*, No. 10-2508, 2014 WL 819422, at *9 (W.D. Tenn. Mar. 1, 2014), *vacated*, 799 F.3d 468.

36. *See id.*

37. *Varsity*, 799 F.3d at 476.

This case presented a question of first impression for the Sixth Circuit: What approach should be taken to determine whether a design's PGS features are distinct and separable from the utilitarian aspects of the article on which they appear?³⁸ Before establishing its own test to determine the copyrightability of PGS works, the court started with a two-part test culled from the language of the Act: (1) whether the design is for a useful article; and (2) if so, whether the PGS features can be identified separately from, and are capable of existing independently of, the utilitarian function of the article.³⁹ "This second question is often referred to as testing the 'separability' of the pictorial, graphic, or sculptural features of the design of a useful article."⁴⁰ The court began its analysis by describing the nine distinct approaches to conceptual separability utilized by other circuits and scholars.⁴¹

The Sixth Circuit then established its own five-pronged test to determine whether a PGS design is copyrightable: (1) whether the design is a PGS work; (2) if it is a PGS work, whether it is a design of a useful article; (3) what are the utilitarian aspects of the useful article; (4) whether PGS features of the design can be identified

38. *Id.* at 481.

39. *Id.*

40. *Id.*

41. *Id.* at 484–85. The court discussed the approaches in the following order: (1) the Copyright Office's approach, which provides for conceptual separability "only if the artistic feature and the useful article could both exist side by side and be perceived [separately]," *id.* at 484 (quoting U.S. COPYRIGHT OFFICE, *supra* note 8, § 924.2(B)); (2) the primary-subsidiary approach, which states that conceptual separability exists "if the artistic features of the design are 'primary' to the 'subsidiary utilitarian function,'" *id.* (quoting *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980)); (3) the objectively necessary approach, which provides that "if the artistic features of the design are not necessary to the performance of the utilitarian function of the article," then the article is conceptually separable, *id.*; (4) the ordinary-observer approach, which defines conceptual separability as "creat[ing] in the mind of the ordinary[, reasonable] observer two different concepts that are not inevitably entertained simultaneously," *id.* (second alteration in original) (quoting *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting)); (5) the design-process approach, which provides for conceptual separability if the design elements reflect the "designer's artistic judgment exercised independently of functional influences," *id.* (quoting *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987)); (6) the stand-alone approach, which provides for conceptual separability if "the useful article's functionality remain[s] intact once the copyrightable material is separated," *id.* (alteration in original) (quoting *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 934 (7th Cir. 2004) (Kanne, J., dissenting)); (7) the likelihood-of-marketability approach, which states that conceptual separability exists when, "even if the article ha[s] no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities," *id.* (quoting *Galiano v. Harrah's Operating Co.*, 416 F.3d 411, 419 (5th Cir. 2005)); (8) Patry's approach, which asks whether designs are "separable from the 'utilitarian aspects' of the article," rather than the article itself, satisfying separability if the discernable PGS features are "capable of existing as *intangible* features independent of the utilitarian *aspects* of the useful article," and are not "dictated by the form or function of the utilitarian aspects of the useful article," *id.* at 485 (quoting 2 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 3:146 (2015)); and (9) the subjective-objective approach, which determines separability by balancing the extent "to which the designer's subjective process is motivated by aesthetic concerns [and the extent] to which the design . . . is objectively dictated by [the article's] utilitarian function," *id.* (quoting Barton R. Keyes, Note, *Alive and Well: The (Still) Ongoing Debate Surrounding Conceptual Separability in American Copyright Law*, 69 OHIO ST. L.J. 109, 141 (2008)).

separately from the utilitarian aspects of the useful article; and (5) whether the useful article's PGS features can exist independently of its utilitarian aspects.⁴²

To answer the last prong of this test, separability, the court utilized both the Copyright Office's approach and the objectively necessary approach.⁴³ It also partially endorsed the design-process approach because the designer's testimony offered insight as to which elements of the designs were essential to the utilitarian function of the article.⁴⁴

By drawing from these tests, the Sixth Circuit followed the general approach of the Second and Fourth Circuits, incorporating multiple separability doctrines into one analysis.⁴⁵ The court emphasized the need for such an approach owing to the complexity of copyright cases, and commented on the difficulty of employing a single separability doctrine for design copyrights.⁴⁶ However, instead of adopting one of the Second's or Fourth Circuit's hybrids, the Sixth Circuit created a new one of its own.⁴⁷

Applying its five-pronged test to Varsity's designs, the Sixth Circuit concluded first that Varsity's designs were two-dimensional works of graphic art.⁴⁸ Second, the court affirmed that cheerleading uniforms do indeed have an intrinsic utilitarian function; they are not produced merely to "portray the appearance of [clothing] or to convey information."⁴⁹

In answer to the third prong, the court rejected Star's contention that the utilitarian aspect of a cheerleading uniform is to identify oneself as a cheerleader.⁵⁰ The court determined that, while also serving a decorative function, the utilitarian aspects of a cheerleading uniform are to cover the body, wick away moisture, and withstand athletic movements.⁵¹ It reasoned that a useful article's decorative function alone does not render it incapable of conceptual separability.⁵²

42. *Id.* at 487–88 (citing 17 U.S.C. §§ 101–102 (2012)).

43. *Id.* at 488–89.

44. *Id.* at 488.

45. *See id.* at 485–87; *Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417 (4th Cir. 2010) (applying the objectively necessary and design-process approaches to conceptual separability); *Chosun Int'l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324 (2d Cir. 2005) (applying the objectively necessary, design-process, and ordinary-observer approaches to conceptual separability).

46. "These cases from the Second and Fourth Circuits illustrate that it is difficult to select one approach to the question whether an artistic design is conceptually separable from the utilitarian aspects of the article. We adopt a similar hybrid approach now." *Varsity*, 799 F.3d at 487.

47. *Id.* at 488–89.

48. *Id.* at 489 (citing 17 U.S.C. § 101 for the proposition that PGS works include two and three-dimensional works of art).

49. *Id.* at 489–90 (quoting 17 U.S.C. § 101 (2012)).

50. "But this is no different than saying that a utilitarian aspect of a cheerleading uniform is to convey to others the fact that the wearer . . . is a cheerleader . . ." *Id.* at 490 (citing 17 U.S.C. § 101 ("A 'useful article' is an article having an intrinsic utilitarian function that is not merely to . . . convey information.")).

51. *Id.*

52. The court stated: "We therefore conclude that a pictorial, graphic, or sculptural work's 'decorative function' does not render it unable to 'be identified separately from,' or '[in]capable of existing independently of, the utilitarian aspects of the article.'" *Id.* at 490–91 (alteration in original) (quoting 17 U.S.C. § 101).

In response to the fourth prong, the Sixth Circuit held that the graphic design elements could be identified separately from the utilitarian aspects of the uniform because they did not enhance the uniform's functionality.⁵³ Since different cheerleading uniforms contained different designs, the court reasoned that the functionality of the uniform does not depend on the specific design imposed on the clothing.⁵⁴ To emphasize this point, the court explained that the interchangeability of these designs illustrates that the designs and the uniform could be found side by side, as separate and distinct concepts.⁵⁵

Finally, the court analyzed whether Varsity's designs could exist independently of the utilitarian aspects of the uniforms, thereby testing the conceptual separability of the uniforms' designs.⁵⁶ The Sixth Circuit explained that all of Varsity's designs could be imposed on different garments, including cheerleading uniforms, t-shirts, warm-ups, and jackets.⁵⁷ Since the designs did not interfere with the way the uniform functioned, they were conceptually separable.⁵⁸ The Sixth Circuit concluded that since Varsity's designs were conceptually separable from the uniforms and not necessary to their utilitarian function, Varsity's two-dimensional designs were copyrightable.⁵⁹ Therefore, it vacated the district court's order granting summary judgment to Star and remanded the case for further proceedings.⁶⁰

As courts and scholars across the nation have noted, this area of copyright law is difficult to resolve.⁶¹ This case comment contends that although the court ultimately reached the proper conclusion, the Sixth Circuit erred in its approach to conceptual separability. First, the court erroneously adopted a broad hybrid test for conceptual separability in the fifth prong of its test for the copyrightability of PGS works. Instead, the court should have only used the more objective primary-subsidary test for conceptual separability because it would have reached the same result more efficiently and avoided issues of aesthetic discrimination.⁶² By implementing its hybrid approach, the Sixth Circuit created weak precedent that will yield unpredictable results and continued confusion in conceptual separability.

53. *Id.* at 491.

54. *Id.*

55. *Id.*

56. *Id.*

57. *Id.*

58. *Id.* at 492 ("We therefore conclude the arrangement of stripes, chevrons, color blocks, and zigzags are 'wholly unnecessary to the performance of' the garment's ability to cover the body, permit free movement, and wick moisture." (quoting *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 419 (2d Cir. 1985)).

59. *Id.*

60. *Id.* at 493.

61. *See id.* at 484 (citing ROBERT P. MERGES ET AL., *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 490 (6th ed. 2012)); *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 669–70 (3d Cir. 1990).

62. *See infra* note 92.

First, the Sixth Circuit erred when it adopted a hybrid approach to determine conceptual separability in PGS works because nine other conceptual separability tests already existed.⁶³ By adopting an approach that combined multiple legal standards, the court not only contributed to the complexity in copyright law, but also added unnecessary subjective components to the conceptual separability analysis. In fact, several U.S. Supreme Court dissenting and concurring opinions in numerous areas of the law have criticized the application of hybrid tests because they are often vague and confusing.⁶⁴

For example, in *Fedorenko v. United States*, the Supreme Court diverted from an established legal standard and instead relied on the plain language of the statutory exception to reach its decision.⁶⁵ Justice Harry Blackmun, concurring in the judgment, expressed his regret over the Court's refusal to employ the *Chaunt* test,⁶⁶ which was already well-settled.⁶⁷ He stated:

63. *Supra* note 41.

64. See *Gisbrecht v. Barnhart*, 535 U.S. 789, 812 (2002) (Scalia, J., dissenting) (disagreeing with the Court's holding because "the Court's hybrid approach establishes no clear criteria and hence will generate needless satellite litigation"); *Batson v. Kentucky*, 476 U.S. 79, 126 (1986) (Burger, C.J., dissenting, joined by Rehnquist, J.) ("Rather than applying straightforward equal protection analysis, the Court substitutes for the holding in *Swain* a curious hybrid. The defendant must first establish a 'prima facie case' of invidious discrimination, then the 'burden shifts to the State to come forward with a neutral explanation for challenging black jurors.'" (citations omitted)); *Hillsboro Nat'l Bank v. Comm'r*, 460 U.S. 370, 417–18 (1983) (Stevens, J., concurring in the judgment in No. 81-485 and dissenting in No. 81-930, joined by Marshall, J.) ("[A] general inconsistent events theory would surely give more guidance than the vague hybrid established by the Court today. The dimensions of the Court's newly fashioned 'fundamentally inconsistent event' version of the tax benefit rule are by no means clear."); *infra* notes 65–72 and accompanying text.

65. 449 U.S. 490 (1981). The issue in this case was whether the petitioner's citizenship could be revoked under the Displaced Persons Act (DPA) of 1948. *Id.* at 493–95. The DPA allowed European refugees who were driven from their homelands to enter the United States, but it excluded those who had acted in concert with or in aid of enemy forces. *Id.* at 495. The petitioner was an armed prison guard at the Nazi concentration camp in Treblinka, Poland. *Id.* at 494. He immigrated to the United States under the DPA and obtained his citizenship in 1970. *Id.* at 496–97. In 1977, the government moved to denaturalize the petitioner and charged him with willfully concealing his wartime involvement, thereby procuring his visa and citizenship illegally or by willfully misrepresenting material facts. *Id.* at 497–98. For concealment of material evidence, the DPA provides, in pertinent part, as follows:

It shall be the duty of the United States attorneys . . . to institute proceedings . . . for the purpose of revoking and setting aside the order admitting such person to citizenship and canceling the certificate of naturalization on the ground that such order and certificate of naturalization were illegally procured or were procured by concealment of a material fact or by willful misrepresentation

8 U.S.C. § 1451(a) (2012) (emphasis added). The exception to the DPA provided that those who had persecuted civilians in aid of the enemy were disqualified from being eligible for visas. *Fedorenko*, 449 U.S. at 510.

66. *Chaunt v. United States*, 364 U.S. 350, 354–55 (1960). This test defined "material facts" in relation to the DPA and the revocation of a person's citizenship. *Id.* The burden of proof fell on the government to show by clear, unequivocal, and convincing evidence either that the facts were suppressed and, if known, would have warranted denial of citizenship, or that their disclosure might have led to other facts that warranted denial of citizenship. *Id.* at 355.

67. See *Fedorenko*, 449 U.S. at 519.

In *Chaunt*, the Court articulated two approaches to provide guidance and uniformity in such inquiries. The Court today adopts what it considers a new and minimal definition of materiality . . . I would rely explicitly upon the *Chaunt* test here and avoid risking the confusion that is likely to be engendered by multiple standards.⁶⁸

Similarly, in *Varsity*, the Sixth Circuit passed over nine conceptual separability tests that were previously utilized by other circuits and created a new test.⁶⁹ The Sixth Circuit had numerous approaches at its disposal, yet it added to the confusion in copyright law by creating its own hybrid test. Importantly, the Sixth Circuit failed to explain why a hybrid test was more practical and efficient than any of the preexisting tests. Much like the majority's approach in *Fedorenko*, the court simply dismissed the opportunity to adopt and apply a preexisting test.⁷⁰

In another criticism of the Court's decision to depart from known standards and employ a new hybrid test, Chief Justice William Rehnquist in *Schlup v. Delo* denounced the majority's analysis and conclusion, stating that the Court had engaged in a "classic mixing of apples and oranges" when it required a showing that combined two prongs from different tests.⁷¹ He continued: "The hybrid which the Court serves up is bound to be a source of confusion. . . . [T]he sensible course would be to modify that familiar standard rather than to create a confusing hybrid."⁷² Instead the Court created a different legal test, a hybrid containing components of prior standards, which was unnecessary because established standards already existed.

68. *Id.* at 520–21.

69. Although the other circuits' approaches to conceptual separability are not binding on the Sixth Circuit, the *Varsity* court could have adopted a specific hybrid approach from another circuit to create uniformity in copyright law and avoid further confusion and unpredictability. Nonetheless, even if the Sixth Circuit adopted another circuit's hybrid, this comment argues that it still would have been an erroneous approach because nine other discrete tests were available.

70. See *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 487 (6th Cir. 2015).

71. 513 U.S. 298, 339 (1995) (Rehnquist, C.J., dissenting). After being charged with and convicted of murdering a fellow inmate, the petitioner filed a habeas corpus petition alleging that a constitutional error deprived the jury of crucial evidence that would have established his innocence. *Id.* at 301–02 (majority opinion). In reviewing the habeas petition, the majority analyzed the *Carrier* and *Sawyer* standards. *Id.* at 318–27. The *Carrier* standard requires a habeas petitioner to show that the constitutional violation has "probably" resulted in the conviction of someone who is actually innocent. *Murray v. Carrier*, 477 U.S. 478, 496 (1986). The *Sawyer* standard requires a petitioner to prove "by clear and convincing evidence that, but for a constitutional error, no reasonable juror would have found the petitioner eligible for the death penalty." *Sawyer v. Whitley*, 505 U.S. 333, 336 (1992). The majority concluded that the *Carrier* standard applied but added that the showing of innocence also requires proof that more likely than not no reasonable juror would have convicted the defendant on the basis of the new evidence. *Schlup*, 513 U.S. at 326, 327, 329. Judge Rehnquist stated:

"More likely than not" is a quintessential charge to a finder of fact, while "no reasonable juror would have convicted him in the light of the new evidence" is an equally quintessential conclusion of law similar to the standard that courts constantly employ in deciding motions for judgment of acquittal in criminal cases.

Id. at 339 (Rehnquist, C.J., dissenting).

72. *Schlup*, 513 U.S. at 339–40 (Rehnquist, C.J., dissenting) (citation omitted).

The Sixth Circuit mimicked the majority's approach in *Schlup* when it took accepted approaches, whether in whole or in part, and combined them to formulate a new standard for conceptual separability. Considering the extent of ambiguity in this area of law,⁷³ it is perplexing that the Sixth Circuit did not adopt an existing test, as Chief Justice Rehnquist recommended in *Schlup*. Rather, the Sixth Circuit added to the confusion surrounding conceptual separability by adopting a hybrid strategy, about which Supreme Court Justices have given ample warning and have implied that the more practical, clear, and efficient approach would be to apply existing standards.

Furthermore, a single, narrowly tailored test furthers the purpose of the Act, benefitting authors of original works, by contemplating the specific characteristics of a particular category of art. "[L]imitation[s] on the scope of copyright law ha[ve] been used to accomplish an expansion of the subject matter of copyright."⁷⁴ Under this theory, if one test applies to garment designs⁷⁵ and another test applies to mannequin faces,⁷⁶ both garment designs and mannequin faces have a distinct conceptual separability test, which affords each broader protection under the Act.⁷⁷ This would allow courts to rely on unambiguous tests for each artistic category, which would afford broader protection to works as a whole.⁷⁸ Had the Sixth Circuit done this, it would have furthered the Act's purpose, by "promot[ing] the nation's culture and learning."⁷⁹ Unambiguous and definitive tests in copyright law encourage creativity and authorship because they protect original works against infringement.

Additionally, there are many practical benefits to using one test for conceptual separability. Judge Jerry E. Smith in *Galiano v. Harrah's Operating Co.* stated:

Sometimes, we must favor what might be a sub-optimal prophylactic rule because it is more determinate than the theoretically superior but hopelessly subjective one. . . . [W]e do conclude that . . . it is not so theoretically infirm

73. "How to conduct the conceptual separation is, in turn, what continues to flummox federal courts." *Galiano v. Harrah's Operating Co.*, 416 F.3d 411, 419 (5th Cir. 2005).

74. Edward Samuels, *The Idea-Expression Dichotomy in Copyright Law*, 56 TENN. L. REV. 321, 346 (1989).

75. See *Galiano*, 416 F.3d at 421.

76. *Id.* ("Surely the Seventh Circuit considered itself as setting forth a test for courts to use when encountering any applied art but . . . courts have not rushed to extend the rule beyond mannequin designs."); see *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 931 (7th Cir. 2004).

77. Conversely, if there is one broad test that applies to both categories of subject matter, the conceptual separability analysis is not precise in its application.

78. Each individual category of art in PGS works would have its own unambiguous test to determine conceptual separability. While definitive tests may result in less protection for a particular kind of PGS work, PGS works as a whole would be entitled to broader protection because there would be fewer gray areas when determining separability and therefore copyrightability.

79. John B. Fowles, *The Utility of a Bright-Line Rule in Copyright Law: Freeing Judges from Aesthetic Controversy and Conceptual Separability in Leicester v. Warner Bros.*, 12 UCLA ENT. L. REV. 301, 305 (2005) (citation omitted); see also L. RAY PATTERSON & STANLEY W. LINDBERG, *THE NATURE OF COPYRIGHT: A LAW OF USERS' RIGHTS* 2 (1991) (discussing the primary purpose of the Act, which is to promote public welfare by encouraging the public to produce and distribute new works).

that such inferiority overcomes the benefits . . . of having a more determinate rule.⁸⁰

A determinate test is fundamental to affording copyright protection to PGS works because it reduces the inherent subjectivity of conceptual separability.⁸¹ Had the Sixth Circuit applied a single test instead of a hybrid to determine only the conceptual separability of fabric designs, it would have avoided the task of attempting to apply this complex test to *all* PGS works in future cases.

Second, the Sixth Circuit should have used the primary-subsidary test⁸² as its single conceptual separability test for fabric designs. Under the primary-subsidary test, conceptual separability exists if the design's artistic features are primary to the article's subsidiary utilitarian function.⁸³ In *Kieselstein-Cord v. Accessories by Pearl, Inc.*, the Second Circuit held that the primary ornamental aspect of the belt buckles at issue was conceptually separable from the belt buckles' subsidiary utilitarian function.⁸⁴ Although the court did not expressly state what that function was, Judge Jack Weinstein's dissenting opinion stated what the majority implied: that the utilitarian function of belt buckles was "to keep the tops of trousers at waist level."⁸⁵ Therefore, the ornamental aspect of the belt buckles was primary to the subsidiary utilitarian function of holding pants around a person's waist.

Viewing the primary-subsidary test in this light shows why it is applicable to fabric designs and thus applicable to the *Varsity* case. The Sixth Circuit recognized that the fabric designs served a decorative purpose,⁸⁶ which is analogous to the Second Circuit's holding in *Kieselstein-Cord* that the belt buckles also served an ornamental purpose.⁸⁷ This illustrates the distinct relationship between the artistic features of the fabric designs and the uniforms' utilitarian function. Since the primary-subsidary test hinges on the distinct, separate relationship between artistic features and utilitarian function,⁸⁸ the court should have adopted this test, clarified its definition,⁸⁹ and limited its application to fabric designs.

80. *Galiano*, 416 F.3d at 421.

81. *See infra* pp. 251–52.

82. *Supra* note 41.

83. *See Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 994 (2d Cir. 1980).

84. *Id.* at 993. The plaintiff designed and manufactured belt buckles with distinct sculptural elements. *Id.* at 990. The plaintiff's customers sometimes wore the belt buckles around the neck or elsewhere on the body as jewelry. *Id.* at 991. The plaintiff commenced a lawsuit after realizing that the defendant's belt buckle designs were substantially similar to the plaintiff's belt buckles. *See id.*

85. *Id.* at 994 (Weinstein, J., dissenting). Judge Weinstein, a district court judge for the Eastern District of New York, heard the case by designation.

86. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 490 (6th Cir. 2015).

87. *Kieselstein-Cord*, 632 F.2d at 993.

88. *See generally id.* (implying a relationship existed between the ornamental aspects of the belt buckles and their utilitarian function of holding pants at waist level).

89. The primary-subsidary test is often criticized for its unspecific guidance in determining what is primary and what is subsidiary. *See Fowles, supra* note 79, at 313–14; *Keyes, supra* note 41, at 123–24;

Conceptual separability is inherently subjective because it tests the balance between artistic features and utilitarian functions.⁹⁰ As a result, the court must naturally make some judgment on artistic features of a work to determine whether or not they are separable from functional features. Despite the subjectivity in separability analyses, the primary-subsidary test has objective components, as it concentrates on the *relationship* between artistic features and utilitarian functions and *not* the artistic features themselves.⁹¹ Therefore, with respect to fabric designs, this test is functionally superior to other conceptual separability tests because the court need only focus on an objective determination: the relationship between artistic features and the utilitarian function of the article into which the fabric designs are incorporated.

Moreover, the primary-subsidary test avoids issues of aesthetic discrimination.⁹² In essence, the principle instructs courts to avoid basing copyrightability determinations on what a judge or fact finder believes is worthy of protection.⁹³ Copyrightability tests should not test the weight of how artistic or aesthetically pleasing the work is to the court but should instead test originality and fixation objectively.⁹⁴ The primary-subsidary test removes the judge's subjective determinations of a work's value made on the basis of her personal aesthetic preferences, and instead relies objectively on whether aesthetics serve a purpose primary to the subsidiary utilitarian function of a work.⁹⁵

Sonja Wolf Sahlsten, Note, *I'm a Little Treepot: Conceptual Separability and Affording Copyright Protection to Useful Articles*, 67 FLA. L. REV. 941, 957 (2015).

90. See Walker & Depoorter, *supra* note 18, at 351–53, 363–67.

91. See *Kieselstein-Cord*, 632 F.2d at 993–94 (considering that the “buckles’ wearers . . . have used them as ornamentation for parts of the body other than the waist” and concluding that the sculptural elements of the belt buckles were primary to their subsidiary utilitarian function).

92. The aesthetic nondiscrimination principle originated from Justice Oliver Wendell Holmes, Jr.’s famous passage in *Bleistein v. Donaldson Lithographing Co.*:

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value,—it would be bold to say that they have not an aesthetic and educational value,—and the taste of any public is not to be treated with contempt.

188 U.S. 239, 251–52 (1903); see also CHISUM ET AL., *supra* note 16, § 4C[1][d] (explaining how courts generally apply this standard).

93. See *supra* note 92.

94. See *Bleistein*, 188 U.S. 239. “To be copyrightable subject matter, a work of authorship must be fixed in a tangible medium of expression ‘from which [it] can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.’” CHISUM ET AL., *supra* note 16, § 4C[2] (alteration in original) (quoting 17 U.S.C. § 102(a) (2012)).

95. See discussion *supra* pp. 250–51.

This test removes the need for aesthetic evaluation in both copyright law and conceptual separability, which “promote[s] objectivity and eliminate[s] questions of taste.”⁹⁶

In deciding which separability tests to implement in the Sixth Circuit, the *Varsity* court alluded to the issue of aesthetic discrimination and stated that it chose not to implement the likelihood-of-marketability test⁹⁷ because of its subjective nature.⁹⁸ By explicitly rejecting the subjective nature of this test, the court seemingly recognized that objective tests are fundamental to determining conceptual separability and ultimately, copyrightability. Considering this acknowledgement, it is troublesome that the court did not implement the objective primary-subsidary approach as its sole conceptual separability test. If it had done so, it would have been one step closer to simplifying this area of copyright law⁹⁹ and creating clear precedent.

Through its implementation and application of a hybrid approach for PGS works, the *Varsity* court made an unforced blunder that effectively prevented it from setting a cogent standard for conceptual separability in the Sixth Circuit. The court stated that “it is difficult to select one approach to the question whether an artistic design is conceptually separable from the utilitarian aspects of the article.”¹⁰⁰ However, this difficulty is primarily evident when courts, like the Sixth Circuit, attempt to categorize all artistic designs into one group and apply a hybrid test. Such tests provide little guidance because it is unclear in any individual legal analysis whether all tests within the hybrid have equal influence.¹⁰¹ Courts must now grapple with the issue of how much weight to assign each element or test of the hybrid in any given case. Consequently, this tug-of-war approach adds to the subjectivity in the conceptual separability analysis because there are multiple factors that influence the application of any particular test to a case’s facts.

Even more problematic for precedent is when hybrid tests are applied inconsistently within the same circuit.¹⁰² Legal standards exist to establish precedent and ensure

96. Walker & Depoorter, *supra* note 18, at 353.

97. *Supra* note 41.

98. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 489 & n.11 (6th Cir. 2015) (citing *Bleistein*, 188 U.S. at 251–52).

99. *See id.* at 496–97 (McKeague, J., dissenting).

It is apparent that either Congress or the Supreme Court (or both) must clarify copyright law with respect to garment design. The law in this area is a mess—and it has been for a long time. The majority takes a stab at sorting it out, and so do I. But until we get much-needed clarification, courts will continue to struggle and the business world will continue to be handicapped by the uncertainty of the law.

Id. (citation omitted).

100. *Id.* at 487 (majority opinion).

101. *See supra* note 12.

102. The Second Circuit has made this error in conceptual separability analyses. *See Jovani Fashion, Ltd. v. Fiesta Fashions*, 500 F. App’x 42 (2d Cir. 2012) (employing a hybrid approach consisting of elements of the ordinary observer approach, the design-process approach, and the primary-subsidary test); *Chosun Int’l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324 (2d Cir. 2005) (employing a hybrid approach to conceptual separability consisting of elements of the objectively necessary approach, the design-process

predictability in the American justice system.¹⁰³ Hybrid tests do not further this purpose when used inconsistently within the same jurisdiction. Although there is potential for courts to reach the same outcome applying different tests, the resulting uncertainty runs contrary to the aim of establishing consistent judicial precedent and makes it difficult for an artist to remain confident that her work will be protected.

A single test for conceptual separability would alleviate conflict and tension within the judicial system because it would make clear what test would apply to a given case, which would provide firm precedent and predictable outcomes.

In light of the above policy considerations, it is unclear why the Sixth Circuit failed to endorse the primary-subsidary test as its sole conceptual separability standard. It furthers the purpose of the Act because it provides greater protection to fabric designers.¹⁰⁴ As many consumers purchase clothing with the purpose of appearing a certain way to others,¹⁰⁵ the primary purpose of purchasing garments is more likely expressive than purely functional, and therefore fabric designs on garments would frequently be protected from infringement under the primary-subsidary test.¹⁰⁶ This limited approach thus affords broader protection¹⁰⁷ to clothing designers and encourages them to be creative.

While the Sixth Circuit ultimately reached the proper conclusion, it erred when it created and applied a hybrid test to the conceptual separability analysis. Not only does this approach generate confusing precedent, but it is also contrary to the purpose of the Act. Had the Sixth Circuit endorsed the primary-subsidary test alone and limited the scope of its application to fabric designs, the court would have reached the same result more efficiently while creating vibrant, bright-line precedent. Instead, the future of conceptual separability and the copyrightability of fabric designs remains in purgatory.

approach, and the ordinary observer approach); see also Walker & Depoorter, *supra* note 18, at 365–67 (discussing the various conceptual separability tests inconsistently employed by the Second Circuit).

103. See Chad M. Oldfather, *Universal De Novo Review*, 77 GEO. WASH. L. REV. 308, 333 (2009).

A fundamental tenet of the American legal system is that like cases should be treated alike. . . . [U]niformity promotes predictability . . . [C]onsistency in the resolution of cases promotes respect for the judiciary by strengthening the perception that judicial decisions are not influenced by political or other extralegal considerations.

Id.

104. See *supra* pp. 250–52.

105. “Aesthetics of dress is about how people choose to appear, and the way they want to look to themselves and others within a particular context.” Marilyn DeLong, *Aesthetics of Dress*, BERG FASHION LIBRARY, <https://www.bloomsburyfashioncentral.com/products/berg-fashion-library/article/bibliographical-guides/aesthetics-of-dress> (last visited Feb. 2, 2017).

106. See *supra* pp. 250–52.

107. Samuels, *supra* note 74, at 346.

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